

1 The opinion in support of the decision being entered today was *not* written
2 for publication in and is *not* binding precedent of the Board.

3
4 UNITED STATES PATENT AND TRADEMARK OFFICE

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6
7 BEFORE THE BOARD OF PATENT APPEALS
8 AND INTERFERENCES
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10
11 *Ex parte* BRIAN J. BROWN, STEVEN L. WEBB, JERLYN R. CULP,
12 MIKE A. FARRELL, and KIMBERLY A. BITNER
13

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15 Appeal 2007-0728
16 Application 09/954,796
17 Technology Center 2100
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20 Decided: April 23, 2007
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23 Before STUART S. LEVY, LINDA E. HORNER, and ANTON W. FETTING,
24 *Administrative Patent Judges.*

25 FETTING, *Administrative Patent Judge.*

26 DECISION ON APPEAL
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29 STATEMENT OF CASE

30 This appeal from the Examiner's rejection of claims 1-44, the only claims
31 pending in this application, arises under 35 U.S.C. § 134. We have jurisdiction
32 over the appeal pursuant to 35 U.S.C. § 6.

33 We AFFIRM and ENTER A NEW GROUND OF REJECTION UNDER
34 37 C.F.R. § 41.50(b).

The Appellants invented a way to distribute software (Specification 1). An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method for distributing software, comprising:
querying a user as to the needs of the user;
receiving user responses to the query;
characterizing the use of the user based upon the user responses; and
providing software programs that may be beneficial to the user based upon the characterization of the use.

This appeal arises from the Examiner's Final Rejection, mailed November 2, 2005. The Appellants filed an Appeal Brief in support of the appeal on April 3, 2006, and the Examiner mailed an Examiner's Answer to the Appeal Brief on June 14, 2006. A Reply Brief was filed on August 18, 2006.

PRIOR ART

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Parthesarathy US 6,353,926 B1 Mar. 5, 2002
(Jul. 15, 1998)

Bradford US 6,678,679 B1 Jan. 13, 2004
(Oct. 10, 2000)

Himmel US 6,742,052 B2 May 25, 2004
(Aug. 9, 2001)

Kroening US 6,859,924 B1 Feb. 22, 2005
(Dec. 12, 2000)

REJECTIONS

Claims 1, 4, 5, 7-12, 14-20, 25-36, 38, 40, and 42¹ stand rejected under 35 U.S.C. § 102(e) as anticipated by Parthesarathy.

Claims 2, 37, 39, and 41 stand rejected under 35 U.S.C. § 103(a) as obvious over Parthesarathy and Bradford.

Claims 6, 13, and 19 stand rejected under 35 U.S.C. § 103(a) as obvious over Parthesarathy and Kroening.

Claims 3, 21-24, and 44² stand rejected under 35 U.S.C. § 103(a) as obvious over Parthesarathy and Himmel.

Claim 43 stands rejected under 35 U.S.C. § 103(a) as obvious over Parthesarathy, Himmel, and Bradford.

¹ Although claims 38, 40 and 42 are not included in the nominal recitation of the statutory rejection (Answer 5), they are included in the analysis of this rejection under 35 U.S.C. § 102(e) (Answer 15-16; Final Rejection 13), and acknowledged by the Appellants (Br. 8).

² Although claim 44 is not included in the nominal recitation of the statutory rejection (Answer 18), it is included in the analysis of this rejection under 35 U.S.C. § 103 (Answer 21-22; Final Rejection 19), and acknowledged by the Appellants (Br. 18).

ISSUES

The issues pertinent to this appeal are

- Claims 1, 4, 5, 7-9, and 38 (Br. 10-12)
 - Whether the art applied shows characterizing the use of the user based upon the user responses.
 - Whether the art applied shows providing software programs that may be beneficial to the user based upon the characterization of the use.
 - Whether the art applied shows querying a user as to the needs of the user.
- Claims 10-12, 14-16, and 40 (Br. 12-13)
 - Whether the art applied shows means for querying a user as to the needs of the user.
 - Whether the art applied shows means for characterizing the use of the user based upon the user responses.
 - Whether the art applied shows means for providing software programs that may be beneficial to the user based upon the characterization of the use.
 - Whether the art applied shows downloading from a storage medium read by the computing device.

1 • Claims 17-20 and 42 (Br. 13-14)

2 ○ Whether the art applied shows logic configured to query a user as to
3 the needs of the user.

4 ○ Whether the art applied shows logic configured to characterize the use
5 of the user based upon the user responses.

6 ○ Whether the art applied shows logic configured to provide software
7 programs that may be beneficial to the user based upon the
8 characterization of the use.

9 ○ Whether the art applied shows logic configured to suggest an
10 alternative selection in response to receipt of a user selection that
11 identifies a software program the user already possesses.

12 • Claims 25-28 (Br. 14)

13 ○ Whether the art applied shows querying a user as to what the user
14 wants to accomplish.

15 ○ Whether the art applied shows providing software programs based
16 upon the user responses.

17 • Claims 29-32 (Br. 14-15)

18 ○ Whether the art applied shows querying a user as to the needs of the
19 user.

20 ○ Whether the art applied shows suggesting software programs based
21 upon the user responses.

1
2 • Claims 33-36 (Br. 15-16)

3 ○ Whether the art applied shows determining tasks a user wishes to
4 accomplish from responses provided by the user.

5 ○ Whether the art applied shows installing software programs based
6 upon the determination.

7 • Claims 2, 37, 39, and 41 (Br. 16-17)

8 ○ Whether there is motivation to combine the art applied.

9 • Claims 6, 13, and 19 (Br. 17)

10 ○ Whether the art applied shows suggesting an alternative in response to
11 receipt of a user selection that identifies a software program the user
12 already possesses.

13 • Claims 3, 21-24, and 44 (Br. 18-19)

14 ○ Whether the art applied shows querying the user as to how the user
15 plans to use a peripheral device (claim 3).

16 ○ Whether the art applied shows querying a user as to what the
17 peripheral device may be used for (claim 21).

18 • Claim 43 (Br. 19-20)

19 ○ Whether the art applied shows querying a user as to what the
20 peripheral device may be used for.

FACTS PERTINENT TO THE ISSUES

The following Findings of Fact (FF), supported by a preponderance of substantial evidence, are pertinent to the above issues.

01. Parthesarathy describes one of its claimed inventions as

A method for updating software, comprising the steps of:
installing software on a local computer;
creating a shortcut link for launching the installed software, wherein said installed software is identified in the shortcut link by version data;
subscribing to a software update channel;
detecting through said software update channel that a new software update is available on a remote computer;
recording data relating to said new software update on said local computer, wherein said data comprises new version data;
comparing said version data stored in said shortcut link with version data from said new software update when said installed software is launched using said shortcut link; and
updating said installed software when said new version data is more current than said version data stored in said shortcut link
... further comprising:
notifying a user that the new software update is available; and
querying the user to determine whether the user desires to load the new software update, wherein said updating of the installed software is performed when, in response to the querying step, the user indicates a desire to load the new software update.

(Parthesarathy, Claim 10, rewritten as it would appear in independent form).

02. A need is something required or wanted³.

³ American Heritage Dictionary (4th ed. 2000).

- 1 03. Thus, Parthesarathy shows querying a user as to the needs of the user, i.e.,
2 whether the user desires to load a new software update.
- 3 04. To characterize is to describe the qualities or peculiarities of⁴.
- 4 05. To determine whether the user desires to load the new software update is to
5 describe the qualities or peculiarities of the user's desires.
- 6 06. Thus, Parthesarathy shows characterizing the use of the user based upon the
7 user responses.
- 8 07. Updating of the installed software performed when, in response to the
9 querying step, the user indicates a desire to load the new software update is a
10 provision of a software program that may be beneficial to the user based on
11 the characterization of the user's desires.
- 12 08. Thus, Parthesarathy shows providing software programs that may be
13 beneficial to the user based upon the characterization of the use.
- 14 09. Parthesarathy shows that its software is distributed over a network
15 (Parthesarathy, col. 1, ll. 35-40).
- 16 10. Software is distributed over a network from a network server that contains a
17 storage medium for the software to the requesting computing device. Such
18 distribution is colloquially referred to as downloading.
- 19 11. Thus, Parthesarathy shows downloading from a storage medium read by the
20 computing device.

⁴ See *supra*, note 3.

1 12. The Examiner admits that Parthesarathy alone does not show an alternative
2 selection in response to receipt of a user selection that identifies a software
3 program the user already possesses (Answer 18).

4 13. The Examiner has provided no support for a rejection of claim 19 over
5 Parthesarathy alone.

6 14. Thus, we cannot say that Parthesarathy alone shows an alternative selection
7 in response to receipt of a user selection that identifies a software program
8 the user already possesses.

9 15. Parthesarathy shows a software application querying a user whether the user
10 wants to load a new software update now, later, or never (Parthesarathy, col.
11 6, ll. 15-20).

12 16. To accomplish is to complete⁵.

13 17. To load a new software update is to complete the updating of the software,
14 or to accomplish the updating.

15 18. Thus, Parthesarathy shows querying a user as to what the user wants to
16 accomplish.

17 19. Parthesarathy shows that if the user wants to accomplish a software update,
18 the software update is loaded (Parthesarathy, col. 6, ll. 23-26).

19 20. Thus, Parthesarathy shows providing software programs based upon the user
20 responses.

⁵ See *supra*, note 3.

- 1 21. Parthesarathy shows sending email notifications of software updates for
2 distribution following the user's subscription to such updates (Parthesarathy,
3 col. 2, ll. 16-22).
- 4 22. Such emails that the user may respond to are suggestions of software
5 programs to be loaded based upon the user's responses in the subscription.
- 6 23. Thus, Parthesarathy shows suggesting software programs based upon the
7 user responses.
- 8 24. Parthesarathy teaches a method to automate software update distribution
9 (Parthesarathy, col. 2, ll. 2-7).
- 10 25. Bradford teaches methods to refine queries, such as those of Parthesarathy
11 (Bradford, col. 1, ll. 10-16).
- 12 26. Himmel teaches a way to connect two devices with a wireless bus, that
13 requires system configuration, which in turn requires software distribution
14 according to the configuration. (Himmel, col. 1, ll. 6-10; col. 2, l. 66 – col. 3,
15 l. 2).
- 16 27. Kroening teaches a method for distributing software components and
17 updates (Kroening, col. 1, ll. 40-46).
- 18 28. Thus, a person of ordinary skill in the art would have looked to combining
19 Bradford, Kroening and Parthesarathy as implementation details of the
20 software distribution required by Himmel's configuration setting.
- 21 29. Kroening shows presenting a user with a list of software components that
22 have updates available (Kroening, col. 9, ll. 36-38 and Figure 4, block 420).
- 23 30. Updated software is different from the original software.

1 31. Thus, Kroening shows suggesting an alternative in response to receipt of a
2 user selection that identifies a software program the user already possesses.

3 32. Himmel shows querying a user whether to accept and configure a peripheral
4 device.

5 33. To accept and configure is an instance of how to use a device.

6 34. Thus, Himmel shows querying the user as to how the user plans to use a
7 peripheral device (Himmel, col. 2, l. 66 – col. 3, l. 2).

8 35. To configure a device is to specify its context and therefore to specify what
9 the device may be used for.

10 36. Thus, Himmel shows querying a user as to what the peripheral device may
11 be used for.

12
13 ANALYSIS

14 *Claims 1, 4, 5, 7-12, 14-20, 25-36, 38, 40, and 42 rejected under 35 U.S.C.*

15 *§ 102(e) as anticipated by Parthesarathy.*

16 From the above Findings of Fact, supported by a preponderance of substantial
17 evidence, we must conclude that

- 18 • The art applied shows characterizing the use of the user based upon the user
19 responses (FF 06).
- 20 • The art applied shows providing software programs that may be beneficial to
21 the user based upon the characterization of the use (FF 08).
- 22 • The art applied shows querying a user as to the needs of the user (FF 03).

- 1 • The art applied shows downloading from a storage medium read by the
2 computing device (FF 11).
- 3 • The art applied shows logic configured to query a user as to the needs of the
4 user and receive user responses to the query (FF 03).
- 5 • The art applied shows logic configured to characterize the use of the user
6 based upon the user responses (FF 06).
- 7 • The art applied shows logic configured to provide software programs that
8 may be beneficial to the user based upon the characterization of the use
9 (FF 08).
- 10 • With respect to claim 19, we cannot say that Parthesarathy alone shows an
11 alternative selection in response to receipt of a user selection that identifies a
12 software program the user already possesses (FF 14).
- 13 • The art applied shows querying a user as to what the user wants to
14 accomplish (FF 18).
- 15 • The art applied shows providing software programs based upon the user
16 responses (FF 20).
- 17 • The art applied shows suggesting software programs based upon the user
18 responses (FF 23).
- 19 • The art applied shows determining tasks a user wishes to accomplish from
20 responses provided by the user (FF 18).
- 21 • The art applied shows installing software programs based upon the
22 determination (FF 20).

1 The Appellants contend that Parthesarathy merely asks the user whether it is
2 okay to download and does not characterize the use of the user (Br. 10-12; Reply
3 Br. 2-4). Essentially, the Appellants are arguing for a more narrow construction of
4 the term “characterizing.” However the term “characterizing” is a very broad term,
5 meaning to describe the qualities or peculiarities of (FF04). In Parthesarathy, the
6 system queries whether the user wants to load the update now, in the future, or
7 never (FF15). As such, the system of Parthesarathy uses the query to obtain
8 information on the particularities of the user’s use of the program, thereby
9 “characterizing” the use, by determining when, and if, the user wishes to download
10 updated software for the program. The Appellants also argue that claim 1 requires
11 that the claimed method decide which programs would be best for the user.
12 However, claim 1 actually requires only a determination that the program might be
13 beneficial, which, given its user’s decision to acknowledge a desire for such a
14 program, Parthesarathy clearly provides. Finally, as to the Appellants’ contention
15 that characterizing means analyzing, we find no lexicographic definition in the
16 Specification to support this assertion.

17 As to the Appellants’ contention that Parthesarathy’s files are downloaded
18 from the Internet rather than from a storage device, the Internet relies on such
19 storage devices as depositories of files for such download and is thus inherent in
20 Parthesarathy’s teachings (FF11).

21 Regarding the Appellants’ contention that Parthesarathy fails to show querying
22 what a user wants to accomplish (Br. 14; Reply Br. 8), this is no more than a
23 species of the genus of characterizing the use which we determined was shown by
24 Parthesarathy *supra*.

1 Accordingly we sustain the Examiner's rejection of claims 1, 4, 5, 7-12, 14-18,
2 20, 25-36, 38, 40, and 42, but we do not sustain the rejection of claim 19 under
3 35 U.S.C. § 102(e) as anticipated by Parthesarathy.

4
5 *Claims 2, 37, 39, and 41 rejected under 35 U.S.C. § 103(a) as obvious over*
6 *Parthesarathy and Bradford.*

7 From the above Findings of Fact, we must conclude that

- 8 • There is motivation to combine the art applied (FF28).

9 The Appellants look to very specific portions of Bradford in their contention
10 regarding a lack of motivation to combine (Br. 16-17). However, Bradford teaches
11 mechanisms to refine queries such as those posed by Parthesarathy. The
12 Appellants contend that Bradford discloses data queries and that Parthesarathy
13 only queries whether to load an update (Br. 16). But any query inherently is a
14 request for data, the fact that Parthesarathy goes further and acts upon the data that
15 is returned from its query does not negate the data that is implicitly returned for
16 that action to take place upon. Whether the data is returned from a database or
17 from data entry is an implementation detail. Bradford suggests that queries in
18 general may need varying levels of specificity. Certainly, the level of query
19 complexity of Parthesarathy Fig. 3 would suggest such a need.

20 Accordingly we sustain the Examiner's rejection of claims 2, 37, 39, and 41
21 under 35 U.S.C. § 103(a) as obvious over Parthesarathy and Bradford.

22
23 *Claims 6, 13, and 19 rejected under 35 U.S.C. § 103(a) as obvious over*
24 *Parthesarathy and Kroening.*

1
2 From the above Findings of Fact, we must conclude that

- 3 • The art applied shows suggesting an alternative in response to receipt of a
4 user selection that identifies a software program the user already possesses
5 (FF 31).

6 The Appellants take a more narrow construction of what a user already
7 possesses than the claim allows (Br. 17). As we note above, if an update is
8 available, that version of the software is an alternative program to the one that the
9 user already possesses (FF30).

10 Accordingly we sustain the Examiner's rejection of claims 6, 13, and 19 under
11 35 U.S.C. § 103(a) as obvious over Parthesarathy and Kroening.

12
13 *Claims 3, 21-24, and 44 rejected under 35 U.S.C. § 103(a) as obvious over*
14 *Parthesarathy and Himmel.*

15 From the above Findings of Fact, we must conclude that

- 16 • The art applied shows querying the user as to how the user plans to use a
17 peripheral device (claim 3)(FF34).
18 • The art applied shows querying a user as to what the peripheral device may
19 be used for (claim 21)(FF36).

20 The Appellants argue for a more narrow construction of how a user plans to
21 use and what something may be used for than the claims allow. To configure is to
22 indicate how what is configured is to be used and what it may be used for (FF33 &
23 35).

1 Accordingly we sustain the Examiner's rejection of claims 3, 21-24, and 44
2 under 35 U.S.C. § 103(a) as obvious over Parthesarathy and Himmel.

3
4 *Claim 43 rejected under 35 U.S.C. § 103(a) as obvious over Parthesarathy,*
5 *Himmel, and Bradford.*

6 From the above Findings of Fact, we must conclude that

- 7 • The art applied shows querying a user as to what the peripheral device may
8 be used for (FF36).

9 Accordingly we sustain the Examiner's rejection of claim 43 under 35 U.S.C.
10 § 103(a) as obvious over Parthesarathy, Himmel, and Bradford.

11
12 NEW GROUND OF REJECTION UNDER 37 CFR § 41.50(B)

13 Pursuant to 37 CFR § 41.50(b), we enter the following new grounds of
14 rejection:

15 *Claims 1-20, 37- 42 are rejected under 35 U.S.C. § 112, second paragraph,*
16 *as failing to particularly point out and distinctly claim the subject matter which the*
17 *applicant regards as his invention.*

18 More particularly, independent claims 1, 10, and 17 have a limitation that
19 programs that may be beneficial to the user are provided. The attribute of
20 beneficence is totally subjective to each individual obviating any possibility of
21 pointing out the scope of the claims with any degree of objective particularity.

22 Reference to undefined standards, regardless of whose views might
23 influence the formation of those standards, fails to provide any direction to one

1 skilled in the art attempting to determine the scope of the claimed invention.
2 *Datamize, LLC v. Plumtree Software, Inc.*, 417 F.3d 1342, 75 USPQ2d 1801 (Fed.
3 Cir. 2005).

4 The remaining claims under this rejection depend from claims 1, 10, and 17,
5 and therefore incorporate the same indefiniteness.

6 OBSERVATIONS AND REMARKS

7 If prosecution continues, the examiner should consider whether the subject
8 matter of claims 29 and 30 do no more than have a user respond to a query, and do
9 not provide software, or anything else that appears to be concrete and tangible, and
10 thus whether these claims are directed toward statutory subject matter.

12 DECISION

13 To summarize, our decision is as follows:

- 14 • The rejection of claims 1, 4, 5, 7-12, 14-18, 20, 25-36, 38, 40, and 42 under
15 35 U.S.C. § 102(e) as anticipated by Parthesarathy is sustained.
- 16 • The rejection of claim 19 under 35 U.S.C. § 102(e) as anticipated by
17 Parthesarathy is not sustained.
- 18 • The rejection of claims 2, 37, 39, and 41 under 35 U.S.C. § 103(a) as
19 obvious over Parthesarathy and Bradford is sustained.
- 20 • The rejection of claims 6, 13, and 19 under 35 U.S.C. § 103(a) as obvious
21 over Parthesarathy and Kroening is sustained.
- 22 • The rejection of claims 3, 21-24, and 44 under 35 U.S.C. § 103(a) as obvious
23 over Parthesarathy and Himmel is sustained.

- 1 • The rejection of claim 43 under 35 U.S.C. § 103(a) as obvious over
2 Parthesarathy, Himmel, and Bradford is sustained.
- 3 • A new ground of rejection of claims 1-20, 37- 42 under 35 U.S.C. § 112,
4 second paragraph, as failing to particularly point out and distinctly claim the
5 subject matter which the applicant regards as his invention is made under
6 37 C.F.R. § 41.50(b).

7

8 Regarding the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides
9 "[a]ppellant may file a single request for rehearing within two months from the
10 date of the original decision of the Board."

11 In addition to affirming the examiner's rejection(s) of one or more claims,
12 this decision contains new grounds of rejection pursuant to 37 C.F.R. § 41.50(b)
13 (effective September 13, 2004). 37 C.F.R. § 41.50(b) provides "[a] new ground of
14 rejection pursuant to this paragraph shall not be considered final for judicial
15 review."

16 37 C.F.R. § 41.50(b) also provides that the appellant, WITHIN TWO
17 MONTHS FROM THE DATE OF THE DECISION, must exercise one of the
18 following two options with respect to the new ground of rejection to avoid
19 termination of the appeal as to the rejected claims:

20 (1) Reopen prosecution. Submit an appropriate amendment of the claims so
21 rejected or new evidence relating to the claims so rejected, or both, and have the
22 matter reconsidered by the examiner, in which event the proceeding will be
23 remanded to the examiner

1 (2) Request rehearing. Request that the proceeding be reheard under § 41.52
2 by the Board upon the same record

3 Should the appellants elect to prosecute further before the examiner pursuant to
4 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35
5 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of
6 the affirmance is deferred until conclusion of the prosecution before the examiner
7 unless, as a mere incident to the limited prosecution, the affirmed rejection is
8 overcome.

9 If the appellants elect prosecution before the examiner and this does not
10 result in allowance of the application, abandonment or a second appeal, this case
11 should be returned to the Board of Patent Appeals and Interferences for final action
12 on the affirmed rejection, including any timely request for rehearing thereof.

13 No time period for taking any subsequent action in connection with this
14 appeal may be extended under 37 C.F.R. § 1.136(a).

15
16 AFFIRMED
17 and
18 NEW GROUND OF REJECTION UNDER 37 C.F.R. § 41.50(b).
19

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21
22 JRG
23
24

Appeal 2007-0728
Application 09/954,796

1 HEWLETT-PACKARD COMPANY
2 Intellectual Property Administration
3 P.O. Box 272400
4 Fort Collins, CO 80527-2400